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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/510,087	02/22/2000	Paul A. Smith	EVS-P-99-017	2705

7590 06/23/2003

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EXAMINER

WALCZAK, DAVID J

ART UNIT	PAPER NUMBER
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3751

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DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/510,087

Applicant(s)

SMITH, PAUL A.

Examiner

David J. Walczak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 12, 13 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 14-17 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election of Species II in Paper No. 21 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 9, 11, 14-17 and 19 read on elected Species II and will be examined herein. Claims 1-8, 12, 13 and 20 are withdrawn from further consideration.

Claim Rejections - 35 USC § 112

Claims 9, 11, 14-17 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Defining the sheath as "covering" (claims 9, 15 and 17) the body is considered to be new matter.

Claims 9, 11, 14-17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As the specification does not define the sheath as covering the writing instrument, defining the sheath as "covering" the writing instrument is unclear, i.e., since portions of the writing instrument are exposed after the sheath is secured, the sheath does not appear to "cover" the writing implement. Defining the sheath in the claims as "partially covering" would be accurate,

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however this language should also be added to the specification in order to provide antecedent basis for the claim language. Such an addition would not be considered new matter as the original drawings support such structure. In regard to claim 14, an antecedent basis for "the clamp" should be defined. Regarding claim 15, it is unclear as to how the sheath can both "cover" the body of the marking instrument (line 7) and leave a portion of the body uncovered (line 10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of Martin et al (hereinafter Martin) and the Applicant disclosure. Martin discloses a marking device covered by a sheath wherein the sheath is secured to the marker by "clamps" (i.e., the stitching shown in the Fischer device which secures the sheath to the marker is considered to be "clamps" in as much as the Applicant has defined the term "clamp"). Although the Fischer reference does not disclose the use of an end cap and a chain, attention is directed to the Martin reference, which discloses an end cap 15 removably attached to the second end of a marking device and a connecting lead 14 extending from the cap in order to enable the marker to be

conveniently stored and secured when not in use. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such a cap and lead onto the Fischer device in order to enable a user of that device to conveniently store and secure the marker when not in use. Further, although the sheath in the Fischer device is not disclosed as having an antibacterial substance thereon, attention is directed to page 7, line 17, of the Applicant's specification, which discloses that such substances are commonly used to coat surfaces in order to render the surface sanitary. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the sheath in the Fischer device with an antibacterial coating in order to render the device sanitary.

Allowable Subject Matter

Claims 9, 11, 14-16 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, first and second paragraphs, set forth in this Office action.

Response to Arguments

Applicant's arguments filed 2/19/03 have been fully considered but they are not persuasive. Regarding claim 17, the Applicant contends that the Martin device does not include a sheath as claimed, however, the Examiner is not relying on the Martin reference for such a feature. As discussed supra, such a feature is taught by Fischer.

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In response to applicant's argument that there is no suggestion/ motivation to combine the Martin and Fischer references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, after reviewing the Martin and Fischer references, one of ordinary skill/knowledge in the art would readily recognize that a cap can be added to the Fisher device since the Martin and Fisher references are analogous in that they both disclose features which can be added to a writing instrument in order to render the instrument more convenient to use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 703-308-0608. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg L. Huson can be reached on 703-308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
June 21, 2003